

REMARKS

Claims 1 through 7 are pending. Claim 7 has been previously withdrawn as being directed to non-elected subject matter. Claims 3 through 7 are canceled without prejudice to, or disclaimer of, the subject matter they contain. Claims 1 and 2 are amended and Claims 8 through 11 are added, both, to encompass infringing subject matter. No new matter is added to the application.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made."

The Office Action maintains the restriction and election of species requirements and makes them final. Applicant elected **Group I** and **phenyl ethyl alcohol** with traverse and respectfully maintain its traversal for the reasons of record.

Double Patenting Rejections

The Office Action provisionally rejects Claims 1 through 6 under 35 U.S.C. §101 based on statutory double patenting of the "same invention" as being unpatentable over Claims 13 through 15 of copending Application No. 09/604,158. In response, Applicant respectfully acknowledges the need to cancel or amend claims **if** ultimately allowed claims in the above-captioned patent application improperly conflict with, or are coextensive in scope. Applicant respectfully requests that this rejection be held in abeyance until allowable subject matter is indicated.

Likewise, the Office Action provisionally rejects Claims 1 through 6 under 35 U.S.C. §101 based on the judicially created doctrine of non-statutory double patenting for allegedly not being "patentably distinct" over Claims 13 through 15 of copending Application No. 09/604,158.

In response, Applicant respectfully acknowledges the need to cancel claims or to file a Terminal Disclaimer if ultimately allowed claims in the above-captioned patent application extend the patent right in the copending patent application. Applicant respectfully requests that this rejection be held in abeyance until allowable subject matter is indicated. If ultimately deemed necessary, then Applicant will file an appropriate Terminal Disclaimer at that time.

Rejections under 35 U.S.C. §112, second paragraph

Claims 3 and 6 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states that the limitation "the plant essential oil compounds or derivatives" in lines 1-2 does not have sufficient antecedent basis. This rejection is respectfully traversed to the extent it may be applicable to the recited claims. Solely in an effort to advance prosecution, Applicant has amended the claims by deleting the term "or derivative thereof."

Additionally, Claims 1 through 6 stand rejected under 35 U.S.C. §112, second paragraph for reciting the limitation "derivative." The Office Action states:

One of ordinary skill in the art would not know how to interpret the metes and bounds of this limitation. A derivation of a chemical compound may be closely patterned after the subject chemical compound or may be loosely patterned after the subject chemical compound, such that it may bear no resemblance or form recognizable as the subject chemical compound which maybe chemically and/or biologically unrelated in function or form t the subject chemical compound.

Office Action at page 3. In response, Applicant respectfully submits that one of skill in the art could readily interpret the metes and bounds of this limitation. Likewise, regarding the term "derivative," Applicant respectfully submits that originally filed claims are clear and definite.

However, solely in an effort to advance prosecution, Applicant has amended the claims to overcome this aspect of the rejection by deleting the term "or derivative thereof."

In view of the above comments, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §112, second paragraph.

Rejections under 35 U.S.C. §102

Claims 1 through 6 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by JP 04059703 ("Reference N") or, JP 04164072A ("Reference O"). Additionally, Claims 1 through 3 stand rejected under 35 U.S.C. §102(b) as being anticipated by Zocchi et al. ("Reference A," U.S. Patent No. 5,719,114) and Lover et al. ("Reference D," U.S. Patent No. 4,368,207). The Office Action states as follows.

JP 04059703 teaches a miticidal composition comprising carvone, p-methyl acetophenone, 2-phenylethyl alcohol, (iso)thymol, methyl benzoate and/or methyl salicylate in the form of emulsions, dispersions, oil preparations, dusts, tablets or propellants.

JP 04164072 teaches a miticide comprising an oxypyrimidine derivative, which was prepared by dissolving, d,l-4-tert-butyl-alpha-phenylethylalcohol in N, -dimethylformamide and sodium hydride to obtain d,l,5-chloro-6-ethyl-1(1-4-tert-butylphenyl) ethoxy) pyrimidine.

JP 04059703 and JP 04164072 anticipate the claimed subject matter.

Office Action at pages 4-5.

Zocchi (A,'114) teaches a detergent comprising essential plant oils (see Column 5, lines 25-41), which exhibit acaricidal activity. In Column 14, lines 12-66, Zocchi teaches plant essential oils used in the making of miticidal compositions. In Column 18, lines 25-60, Zocchi teaches a contact pesticidal for the control of mites comprising phenyl ethyl alcohol.

Lover teaches a contact composition for the control of mites, wherein the composition comprises 2-phenylethanol (see Column 4, lines 47-60), and an acceptable carrier.

The references of Zocchi and Lover anticipate the claimed subject matter.

Office Action at page 5.

Further, Claims 1 through 6 stand rejected under 35 U.S.C. §102(e) as being anticipated by Zocchi et al. ("Reference B," U.S. Patent No. 5,985, 814), Zocchi et al. ("Reference C," U.S. Patent No. 6,087,402), and Bessette et al. ("Reference E," U.S. Patent No. 6,004,569). The Office Action states as follows.

Zocchi (B, '814) teaches a miticidal, carpet-cleaning composition comprising plant essential oils as an acaricidal agent (see Column 6, lines 33-60), and an acceptable carrier. The referenced composition taught by Zocchi is in the form of a contact liquid or hydrocarbon propellant (see Column 4, lines 51-63). In Column 11, lines 35-67 to Column 12, lines 1-32, Zocchi teaches that the acaricidal agents comprise a monocyclic, carbocyclic ring structure having six-members and substituted by at least one oxygenated or hydroxyl functional moiety. See Claims 1-16.

Zocchi (C, '402) teaches a foam composition for killing dust mites comprising an acaricidal agent and water. The acaricidal agents taught by Zocchi are essential plant oils, such as phenyl ethyl alcohol. See column 5, lines 6-17. See Claims 1-5.

Bessette teaches a pesticide comprising plant essential oils and an acceptable carrier, wherein the plant essential oil comprises a six member carbon ring and having substituted thereon at least one oxygenated functional group (see Column 3, lines 41-47). In Column 4, lines 10-15, Bessette teaches phenyl ethyl alcohol as a compound comprising the referenced composition, which is effective against mites (see Table 13 in Column 13, lines 35-43). The compositions taught by Bessette are in the form of wettable powder, a waterproof dust, a shampoo, a gel, and an aerosol spray.

Office Action at page 6.

Applicant respectfully traverses the above-mentioned rejections for at least the following reasons.

The initial burden of establishing a prima facie basis to deny patentability to a claimed invention under any statutory provision always rests on the Patent Office. *In re Mayne*, 104 F.3d 1339, 41 U.S.P.Q.2d 1451 (Fed. Cir. 1997); *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). Applicants respectfully submit that the Office Action has not discharged this initial burden. The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention. *The Kegel Co.*

v. *AMF Bowling*, 127 F.3d 1420, 44 USPQ2d 1123 (Fed. Cir. 1997); *Gechter v. Davidson*, 116 F.3d 1454, 43 USPQ2d 1030 (Fed. Cir. 1997). In rejecting a claim under 35 U.S.C. §102, the PTO is required to identify wherein a particular reference identically discloses each feature of the claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). There are significant differences between the presently claimed invention and the cited references.

Reference N does not anticipate Applicant's invention as recited in the claims. Reference N merely discloses a composition comprising a mixture of carvone, p-methyl acetophenone, 2-phenylethyl alcohol, (iso)thymol, methyl benzoate and/or methyl salicylate as a mite repellent. Reference N, however, does not disclose each and every element of the invention, as presently recited in the claims against mold mites. Reconsideration and withdrawal of this rejection are respectfully requested.

Reference O does not disclose Applicant's invention as recited in the claims. At best, Reference O merely discloses dl-5-Chloro-6-ethyl-[-(4-tert-butylphenyl)ethoxy] pyrimidine as a control for mites. Reference O does not teach phenyl ethyl alcohol as the active miticide. Rather, Reference O teaches the synthesis of dl-5-Chloro-6-ethyl-[-(4-tert-butylphenyl)ethoxy] pyrimidine involving the dissolution of d,l-4-tert-butyl-alpha-phenethylalcohol in N,N-dimethylformamide and sodium hydride, and the addition of 4,5-dichloro-6-ethylpyrimidine. Thus, Reference O does not disclose the claimed invention. Reconsideration and withdrawal of this rejection are respectfully requested.

Neither Reference A nor Reference D discloses Applicant's invention as recited in the claims. Reference A merely discloses a microemulsion cleaning composition comprising phenyl

ethyl alcohol against dust mites. At best, Reference D discloses a toxic composition against lice and their ova, and scab mites. Applicant respectfully submits that neither Reference A nor Reference D discloses the specific miticidal compositions, as presently recited in the claims against mold mites. Reconsideration and withdrawal of the rejections over these references are respectfully requested.

Reference B does not disclose Applicant's invention as recited in the claims. Reference B only discloses phenyl ethyl alcohol as a member of a long list of other plant essential oils which may be one of many substitutes for perfume and secondly may have acaricidal activity. Reference B does not specifically disclose phenyl ethyl alcohol as an acaricidal compound, let alone being miticidally effective against mold mites. As a result, Reference B fails to disclose Applicant's claimed invention. Thus, reconsideration and withdrawal of this rejection is respectfully requested.

As acknowledged in the Office Action, Reference C teaches compositions for controlling dust mites. Likewise, Bessette et al. teaches methods for controlling insects using the disclosed pesticidal mixtures. Applicant respectfully submits that Reference C and Bessette et al. do not disclose the specific miticidal compositions, as presently recited in the claims against mold mites.

Moreover, to whatever extent the imposed rejections are predicated upon the doctrine of inherency, such reliance is totally misplaced. As mentioned, References O, A, D, B, C and Bessette et al. merely relate to, in relevant part, phenyl ethyl alcohol compositions against dust mites, spider mites or scab mites. These references do not disclose compositions against mold mites. Indeed, these references are conspicuously mute to the fundamental concept of controlling mold mites. This fundamental difference alone between the claimed invention and

References O, A, D, B, C or Bessette et al. is sufficient to undermine the factual determination of lack of novelty under 35 U.S.C. §102. *See Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Furthermore, it is well settled that the doctrine of inherency requires both certainty and art recognition. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 167 (Fed. Cir. 1994); *Electro Medical Systems S.A. v. Cooper, Life Sciences, Inc.* 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Probabilities or possibilities are not sufficient to establish inherency. *In re Oelrich*, 666 F.2d 578, 581-82 (Fed. Cir. 1993). References O, A, D, B, C and Bessette et al. all fail to satisfy the requirement for certainty coupled with art recognition. It is not apparent, and the PTO has not identified, wherein these cited references lies a disclosure of the activity of the presently claimed compositions. In fact, the PTO specifically sets forth in the Office Action its presumption that compositions comprising six member carbon rings having substituted thereon at least one oxygenated functional group translate to all species merely due to the presence of phenyl ethyl alcohol. There is no basis upon which to predicate the determination that the use of phenyl ethyl alcohol in accordance with the teachings of References O, A, D, B, C and Bessette et al. necessarily involves the control mold mites. Accordingly, there is no basis upon which to invoke the doctrine of inherency. Thus, reconsideration and withdrawal of these rejections are respectfully requested.

CONCLUSION

Early consideration and prompt allowance of the pending claims are respectfully requested. If anything could be done to place this application in condition for allowance, e.g., by

Examiner's Amendment, Applicants respectfully request that the Examiner contact the undersigned representative at the telephone number listed below.

To the extent necessary, please grant any extension of time deemed necessary for entry of this communication. Please charge any deficient fees, or credit any overpayment of fees, to Deposit Account 500417.

Respectfully submitted,

McDermott, Will & Emery



Kelli N. Watson

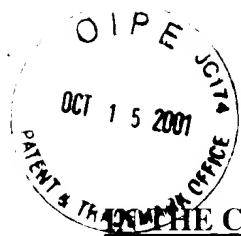
Registration No. 47,170

Willem F. Gadiano

Registration No. 37,136

DATE: October 15, 2001

MCDERMOTT, WILL & EMERY
600 Thirteenth Street, N.W.
Washington, D.C. 20005-3096
(202) 756-8351 (direct)
(202) 756-8087 (fax)



ATTACHMENT

Version With Markings To Show Changes Made

THE CLAIMS

1. (Amended) A ~~contact pesticidal composition~~ for the control of mold mites comprising, in admixture with an acceptable carrier, at least one ~~plant essential oil compound, or derivative thereof~~ selected from the group consisting of aldehyde C16 (pure), α -terpineol, amyl cinnamic aldehyde, amyl salicylate, anisic aldehyde, benzyl alcohol, benzyl acetate, cinnamaldehyde, cinnamic alcohol, carvacrol, carveol, citral, citronellal, citronellol, p-cymene, diethyl phthalate, dimethyl salicylate, dipropylene glycol, eucalyptol (cincole), eugenol, iso-eugenol, galaxolide, geraniol, guaiacol, ionone, menthol, methyl anthranilate, methyl ionone, methyl salicylate, α -phellandrene, pennyroyal oil, perillaldehyde, 1- or 2-phenyl ethyl alcohol, 1- or 2-phenyl ethyl propionate, piperonal, piperonyl acetate, piperonyl alcohol, D-pulegone, terpinen-4-ol, terpinyl acetate, 4-tert butylcyclohexyl acetate, thyme oil, thymol, metabolites of trans-anethole, vanillin, and ethyl vanillin, wherein the compound is miticidally effective against mold mites.

2. (Amended) ~~A~~The ~~pesticidal composition of claim 1~~ for the control of mold mites comprising, in admixture with an acceptable carrier, at least one ~~wherein the compound~~ plant essential oil or derivative thereof, ~~comprising~~es a monocyclic, carbocyclic ring structure having six-members and substituted by at least one oxygenated or hydroxyl functional moiety, ~~wherein the plant essential oil is miticidally effective against mold mites.~~

3. [CANCEL]

4. [CANCEL]

5. [CANCEL]

6. [CANCEL]

7. [CANCEL]

8. A pesticidal composition for the control of mold mites comprising 2-phenyl ethyl alcohol in admixture with an acceptable carrier.

9. A pesticidal composition for the control of mold mites comprising 2-phenyl ethyl propionate in admixture with an acceptable carrier.

10. A pesticidal composition for the control of mold mites comprising trans-anethole in admixture with an acceptable carrier.

11. A pesticidal composition for the control of mold mites comprising benzyl alcohol in admixture with an acceptable carrier.